

REMARKS/ARGUMENTS

Reconsideration of this application in light of the above amendments and following comments is courteously solicited.

Specific reference is made to the final rejection, Applicants' subsequent Request for Reconsideration, and the examiner's Advisory action of October 26, 2006. In that Advisory action the examiner sets forth the following:

1) "Applicant's argument regarding the presence of nitrous acid in the coating solution of Bengston in view of Tomlinson and the supporting document "The Conditions of Chemical Change Between Nitric Acid and Certain Metals" (Chemical Abstract) are not convincing since the Chemical Abstract document appears to be directed to CERTAIN metals such as copper, mercury, and bismuth rather than the magnesium metal as disclosed by Bengston in view of Tomlinson. Furthermore, the concentration of nitric acid as disclosed by the Chemical Abstract is also an important factor in the formation of nitrous acid. There are also conditions under which nitrous acid is destroyed as fast as it is generated. The examiner cannot draw the conclusion that the coating solution of Bengston in view of Tomlinson contains nitrous acid directly from the disclosure of the Chemical Abstract. Therefore, the examiner does not find applicant's arguments based on the teachings of the Chemical Abstract persuasive."

In response to the Examiner's comments Applicant submits herewith as Exhibit I a paper from January 1944 entitled Behaviors of Metals in Nitric Acid. This paper describes in detail the cathodic reduction sequence of nitric acid which involves the generation of nitrous acid. This reduction sequence is an intrinsic behavior of nitric acid and, as can be seen from the Evans paper, is independent of the metal oxidation taking place. Therefore, the formation of nitrous acid would occur with the magnesium metal disclosed by Bengston

in view of Tomlinson. With regard to the destruction issue, Evans is clear that nitrous acid is a byproduct which would result from the cathodic reduction sequence for nitric acid. Applicants believe that the Evens article clearly addresses the examiner's point as quoted above. A second position argued by the examiner in his Advisory action is as follows:

2) "Applicants further arguments on the use of "consisting essentially of" language and the interchangeability of titanium of Matsushima and the zirconium of Tomlinson are not persuasive since "consisting essentially of" language does not exclude the presence of additional elements that do not materially affect the claimed invention. In this case applicant has not provided factual evidence that the presence of additional elements such as titanium in the coating composition as taught by Bengston in view of Tomlinson materially affects the claimed coating solution. In addition, the titanium and zirconium interchangeability argument previously presented by the examiner is intended to assist in showing the similarities between the coating solution of Matsushima in view of Oppen and the coating solution of Tomlinson in order to arrive at the conclusion that the coating solution of Matsushima in view of Oppen can also be applied to magnesium surfaces with expected success. Therefore, the examiner's reasoning is not a result of hindsight reconstruction as alleged by the applicant."

In response to this point Applicants have amended independent claim 7 to set forth the pH of the solution in the process of the present invention as being between 5 to 7. Support for this amendment is set forth in the third paragraph of the Detailed Description of the instant application. In this regard it is seen that the Tomlinson reference requires a pH of less than 5 while Bengston requires a pH of less than 4. This is because of the titanium zirconium components. By drafting claim 7 in "consisting essentially of language" and providing for a "pH of

between 5 to 7" it is respectfully submitted that these references cannot be used in an effective rejection against the process of independent claim 7.

In light of the foregoing, it is submitted that all of the claims as pending patentably define over the art of record and an early indication of same is respectfully requested.

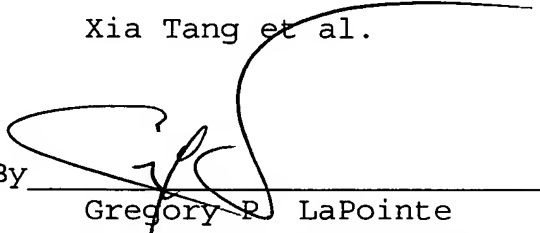
An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would be helpful in resolving any outstanding issues which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

It is submitted that the claims as amended herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

If any additional fees are required in connection with this case, it is respectfully requested that they be charged to Deposit Account No. 21-0279.

Respectfully submitted,
Xia Tang et al.

By



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I, Rachel Piscitelli, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on March 13, 2007.

